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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/739,750 | 12/20/2000 | Hiroshi Takanashi | 2000_1749 | 4981 |

513 7590 12/11/2002

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

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| EXAMINER |
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LEE, SIN J

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| ART UNIT | PAPER NUMBER |
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1752

DATE MAILED: 12/11/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.



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| 09/739,750 | 12-20-00 | Takanashi, Hiroshi | 2000-1749 |

| EXAMINER |
|------------|
| Sin J. Lee |

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| 1752 | 10 |

DATE MAILED:

Below is a communication from the *EXAMINER* in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
 - (b) ☐ they raise the issue of new matter. (see NOTE below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: please see attachment
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 1 and 3-5
- Claim(s) withdrawn from consideration: _____

9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

Sin J. Lee

Dec. 9, 2002

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DETAILED ACTION

1. Claims 1 and 3-5 are rejected under 35 U.S.C. 112, first paragraph as addressed in Paragraph 8 of the last Office action, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants argue that if the amount of all the other components (components (A) to (D)) are defined on the basis of total solid content of the composition and component (E) is defined on the basis of the composition inclusive of solvent, confusion would occur, and one skilled in the art would not perform such calculation. However, even if that might be true, what is clearly shown nonetheless in present specification as originally filed is that while the amount for all the other components ((A) to (D)) are expressed in "wt % of the *total solid components* of the photosensitive resin composition", the amount of (E) is expressed simply in "wt % based on the weight of the photosensitive composition" (no where in the specification it is mentioned that the wt% amount of present component (E) is also based on the total solid components of the photosensitive resin composition).

2. Also, upon reconsideration, the Examiner would like to point out that applicants' Examples 1-34 shown in Table I do not prove unexpectedly superior results of using the component (E) in the amount of *1.0-2.0 wt%* based on the weight of the photosensitive resin composition (as solids). That is, in the Table I, the best results show when the component (E) is

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used in the amount of 1.0-2.0 *parts by weight* along with 200 parts by weight of water, 200 parts by weight of polyvinyl alcohol, 70 parts by weight of polyethylene glycol diacrylate, 4 parts by weight of benzyldimethyl ketal, and 0.1 part by weight of methyhydroquinone (see [0056] of present specification). Therefore, the amount of 1.0-2.0 parts by weight for the component (E) shown in Table I is specific for the case of present examples 1-34 only, and this amount is not the same as the presently claimed 1.0-2.0 wt%. Therefore, it was the Examiner's misstatement when she stated (based on Table I) that applicants demonstrated the unexpected superior result of using p-toluene sulfonamide in the range of 0.5-2.0 wt%.

3. Due to the reasons stated above in Paragraph 2, the previously made 103(a) rejections on claims 1 and 3-5 over Pine'640 (see Paragraph 10 of the last Office action) and the previously made 103(a) rejections on claims 1 and 3-5 over Tanaka et al (JP'653) (see Paragraphs 11 and 12 of the last Office action) still stand; Pine teaches the amount of present component (E) to be ranging from 0-18 wt% (excluding the solvent) and Tanaka teaches the amount of present component (E) to be ranging from 0.49-7.14 wt% (excluding solvent). Both of these ranges overlap with present ranges, and as explained above, applicants have not shown unexpectedly superior results of using the component (E) in the amount of 1.0-2.0 wt% based on the weight of the photosensitive resin composition (as solids).

4. Applicants additionally argue that the relevant disclosures of Tanaka are limited only to the fact that p-toluene sulfonamide is incorporated so as to obtain improved adhesion of the compound of the substrate and that Tanaka is silent about the effects of the present invention

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(i.e., remarkably improved depth of non-printing area on the photosensitive resin plate and improved resolution). Applicants argue that therefore those skilled in the art would not be motivated to make the present invention by use of the respective components in the defined ranges so as to yield the effect of the present invention. However, the fact that Tanaka uses its p-toluene sulfonamide for the different reason than that of present invention is not important because what matters here is that the prior art clearly teaches the use of the aromatic sulfonamide compound such as p-toluene sulfonamide and the motivation provided by the prior art for using such component does not have to be the same as that of present invention.

Based on the amount of the p-toluene sulfonamide calculated from Tanaka's Examples, applicants argue that Tanaka fails to disclose or suggest the criticality of the range of component (E) as presently recited in claim 1. However, as explained previously, Tanaka clearly teaches that the amount of the p-toluene sulfonamide to be ranging anywhere from 0.49 wt% to 7.14 wt% (excluding any solvent), and in the absence of applicants' showing of criticality of present range of 1.0-2.0 wt% (based on solid components), the prior art's range which overlaps with present range would have made the present range *prima facie* obvious.

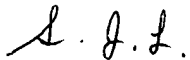
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is (703) 305-0504. The examiner can normally be reached on Monday-Friday from 8:30 am EST to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the

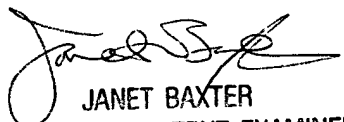
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organization where this application or proceeding is assigned is (703) 872-9311 for after final responses or (703) 872-9310 for before final responses.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.



S. Lee
December 9, 2002



JANET BAXTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700